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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,490	12/05/2003	Scott M. Williams	SW-1-gw	3137

23647 7590 10/22/2010

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EXAMINER	
DINH, TIEN QUANG	

ART UNIT	PAPER NUMBER
3644	

MAIL DATE	DELIVERY MODE
10/22/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/729,490	WILLIAMS, SCOTT M.	
	Examiner	Art Unit	
	Tien Dinh	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/9/10*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,19 and 20* is/are pending in the application.

4a) Of the above claim(s) *20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4 and 19, drawn to a method for a photosensitive cockpit whidshield, classified in class 244, subclass 129.3.

II. Claim 20, drawn to a method of retrofitting, classified in class 244, subclass 129.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different mode of operations and design.

Newly submitted claim 20 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The method as claimed are distinct from that of invention I.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 20 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the layers of polarizers and liquid crystal elements that are used together must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not adequately described in the specification as to how the polarizers are integrated into the window. Where is the detail of the polarizer being disclosed so as to allow a person skilled in the art to understand the invention?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by Dockery 3695681.

Dockery discloses a windshield that is photosensitive with means to adjust the sensitivity of the window to the light to adjust the opacity of the windshield. Please note that the windshields can be used in any desired elements such as trains, buildings, etc.
The portion of the windshield that is photosensitive is surrounded by an area of the windshield that is not includes elements 18, 20, 22, etc. See figures. Please note that a portion of the window has a photosensitive area and some portions do not. The control module (see figure 6)

has controls for controlling the photosensitive circuit 106, the shade opacity 116, and light sensitivity 110.

Re amended portions in claim 1, the photo-sensitive portion has a lamination of different layers including polarizers (column 3, line 62-68 and column 4, line 50) and liquid crystal (see column 5, lines 1-16 and part 14).

Re claim 4, the examiner believes that there is a mean to adjust the response rate since the unit is an electronic unit and that electronic parts are programmable. This is disclosed in column 3, lines 40-52. The applicant is also advised to look at the third paragraph of the finding of facts in the BPAI decision dated 12/14/09.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dockery.

Re claim 4, the response rate is a well known design step that one skilled in the art can use in order to have the effect desired for passenger comfort. A delay in operation of an element is well known in this day and age. Plus, applicant has not provided any criticality to the response rate. A person skilled in the art would have used a desired "response rate" in Dockery's system

in order to create the desired effect so as to dim or un-dim the window in order to allow the most comfortable amount of light inside the vehicle. In addition, applicant has not provided any criticality as to why the use of polarizers is important. This is clearly demonstrated by the lack of disclosure about the polarizers.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf et al in view of Dockery.

Wolf et al teaches glass which can be used in windshields for cars/aircrafts that has means to adjust opacity of the glass. Wolf et al is silent on the means to automatically adjust the opacity of the glass with changes in the light intensity and various dials to adjust the light sensitivity or response rate of the glass. However, Dockery teaches that means to adjust the opacity of the windshield with changes in the light intensity and various dials to adjust the light sensitivity or response rate of the glass are well known in the art.

It would have been obvious to one skilled in the art to have used means to adjust the opacity of the windshield with changes in the light intensity and various dials to adjust the light sensitivity or response rate of the glass in Wolf et al's system as taught by Dockery to allow the system to be operated automatically.

Please note that it is obvious to one skilled in the art to have used the glass in any environment including lighthouses or boat, etc. to allow the control of light to enter a building/vehicle.

Re amended portion in claim 1, the photo-sensitive portion has a lamination of different layers including polarizers (column 3, line 62-68 and column 4, line 50) and liquid crystal (see column 5, lines 1-16 and part 14).

Re amended claim 4, the examiner believes that there is a mean to adjust the response rate since the unit is an electronic unit and that electronic parts are programmable. This is disclosed in column 3, lines 40-52. The applicant is also advised to look at the third paragraph of the finding of facts in the BPAI decision dated 12/14/09.

As an alternative rejection, the response rate is a well known design step that one skilled in the art can use in order to have the effect desired for passenger comfort. A delay in operation of an element is well known in this day and age. See Christmas lights as an example. Plus, applicant has not provided any criticality to the response rate. A person skilled in the art would have used a desired "response rate" in Wolf's system in order to create the desired effect so as to dim or un-dim the window in order to allow the most comfortable amount of light inside the vehicle.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf as modified by Dockery as applied to claim 1 above, and further in view of Jacob 4641922.

Wolf as modified by Dockery teaches all claimed parts except for the transparent portion surrounding the photosensitive portion. However, Jacob teaches that transparent portion surrounding a photosensitive portion is well known. See the abstract.

A person skilled in the art would have used transparent portion surrounding a photosensitive portion in Wolf's system as modified by Dockery and as taught by Jacob in order to allow some light to enter at all time.

Applicant has also not provided any criticality as to why a transparent portion surrounding the photosensitive portion is critical.

Response to Arguments

The applicant's requested for interview with response filed 8/9/10 is noted, however, applicant has not called the examiner to set up a date or time. A call to the examiner will be quicker and will get the examiner's attention well before the examiner act on the amendment.

Applicant has argued that both Wolf and Dockery failed to teach "photoelectric liquid" and that this is not a liquid crystal element. However, the examiner disagrees with applicant's assertion that this is the case. Photoelectric liquids are indeed liquid crystal. This meets what has been claimed.

Plus, applicant has argued that there is no response rate control in Wolf or Dockery. The examiner respectfully disagrees. The applicant is advised to see paragraph 3 of the Findings of Fact in the BPAI decision dated 12/14/09. The response rate of the photosensitive portion is controlled automatically in response to the ambient light falling on the photoelectric cell. The adjustment of the response rate is clearly a step that a skilled person in the art can adjust during the design process and utilized in the control unit in order to have the desired effect from the incoming light through the window.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tien Dinh whose telephone number is 571-272-6899. The examiner can normally be reached on 12-8.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Collins can be reached on 571-272-6886. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tien Dinh/
Primary Examiner, Art Unit 3644